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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,526	05/30/2000	Uwe Ernst	192376USO	8289

7590

02/07/2002

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EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 02/07/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-18

Office Action Summary

Application No.

580526

Applicant(s)

60r1

Examiner

Handicks

Group Art Unit

1704

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/29/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above claim(s) 6, 7, 13-20, 23 is/are withdrawn from consideration.
- ☐ Claim(s) 4 is/are allowed.
- ☒ Claim(s) 1-5, 8-12, 21, 22 is/are rejected.
- ☐ Claim(s) 1-23 is/are objected to.
- ☒ Claim(s) 1-23 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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Applicant's election of Group I and silicate in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

It is noted that Claims 13-20 and 23 are nonelected. The additional election of stationary bed and oil are irrelevant, as Groups II and III are nonelected. Additionally, claims 6 and 7 do not recite a silicate filler and also are nonelected. However, the requirement has been reconsidered to the extent that claims 12 and 22 are now being examined with Group I- *only in so far as the patentability of the 'material or apparatus' resides in the composition of the adsorbent of Group I*. If applicant believes these claims are patentable for other reasons, this should be stated on the record.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 8-12, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A) Claim 1 is an improper Markush Group, as the members are not mutually exclusive. More particularly, the claim should be limited to the elected specie. See also claim 21.
- B) In claim 2, 3 and 6-10, 'phr' should recite 'per 100 parts rubber' if intended.
- C) In claim 1, 'pulverulent' is unclear as to what exactly is encompassed. If a particular particle size, or even process step, is meant, it should be recited. Moreover, this term appears inconsistent with hose, etc. claim 12.
- D) In claim 3, q is not per se defined. There is implicit support for reciting q=1 or 2.

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E) In claim 4, 'permanently' is unclear in that it is impossible to ascertain- and nothing is truly 'permanent'. The term should be deleted.

F) Claims 2 and 10 appear to be duplicates.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 12, 21 and 22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolff et al.

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The reference teaches in column 2 organosilicon-treated silicates, with rubber. No difference is seen in the 'pulverulent' limitation, since it is old and known that tires 1) degrade and emit flakes in normal operation and 2) are shredded when recycled (the examiner takes Official notice that these are true). The minerals recited also sodium aluminosilicates. Claim 12 is taught by the conventional uses of column 2 lines 50-55. Concerning claim 22, the intended use does not limit the material.

Claims 1-5, 10-12, 21 and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gorl et al.

The reference teaches in columns 2 and 6 silica 'as sodium silicate' treated with the claimed organosilicon material and compounded into rubber. 250 phr is taught. The reference is 'by another'. As the silica is in the form of silicate, or the two are readily interconvertible, no patentable distinction is seen in the silica of the reference versus the silicate claimed. Claim 11 is suggested by the teaching of rubber powders.

The 'IDS' filed has been considered.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson
examiner Art Unit 1754